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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,950	07/19/2001	Robert C. Getts	4081.006	1927

7590 01/23/2008
Morris E. Cohen
1122 Coney Island Avenue Suite 217
Brooklyn, NY 11230

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
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1637

MAIL DATE	DELIVERY MODE
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01/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/908,950

Applicant(s)

GETTS ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' response to the office action filed on October 30, 2007 has been considered and acknowledged.

Status of the Application

2. Claims 1-58 are currently pending. All arguments and amendment have been fully considered and thoroughly reviewed and deemed persuasive in-part for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The action is made FINAL necessitated by Amendment.

New rejections necessitated by Amendment

3. Claims are objected to because of the following informalities:

Claims 33-35 are objected because the claims recite 'RNA reagent'. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112: ◦

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33-35 recite the limitation "the RNA reagent" in line 2 of the claims. There is insufficient antecedent basis for this limitation in the claim. The meets and bounds are unclear

whether the claims encompass RNA or RNA reagent. Amendment to recite RNA would obviate the rejection.

Response to arguments:

5. With regard to the objection to the specification, Applicants' arguments and replacement drawings have been fully considered and found persuasive. The objection is withdrawn herein in view of the amendment.

6. With regard to the rejection of claims 47-51, 57-58, under 35 USC 112 and 101, Applicants' arguments and amendment have been fully considered and the rejection is withdrawn herein in view of the amendment.

7. With regard to the rejection of claims 1-58 under 35 USC 103(a) as being obvious over Dellinger et al. in view of Barbera-Guillem and further in view of Weston et al., Van Ness et al., Coultee et al. and Knight et al. respectively, Applicants' arguments are fully considered and found unpersuasive. Applicants argue that the amendment as recited read only one RNA and excludes cDNA. Thus the amendment overcomes the rejection and addresses the stability issues associated with RNA in the prior art references. Applicants' arguments are fully considered and found unpersuasive. Examiner notes that the primary reference is drawn to detect RNA in the target sample not cDNA. Thus the amendment excluding cDNA does not change the scope of the rejection. The previous arguments were based on RNA reagents which include cDNA, and the instant amendment deletes reagent to narrow the claims to read only on RNA, however, Examiner notes that as discussed in the rejection the primary reference Dellinger et al. is primarily drawn to a RNA target (mRNA) not to a cDNA. Thus the scope of the claims remains unchanged and the rejections are maintained herein.

8. With regard to claims 57 and 58, Applicants argue that the claims are not addressed and request that the claims be examined in view of the amendment. Applicants' arguments have been fully considered and found unpersuasive. Examiner notes that the previous office action addressed the claims 57 and 58 (see page 13-15 of the previous office action). The rejections are maintained as the scope of the claims remain unchanged as discussed above. Accordingly the rejections are maintained.

9. With regard to the double patenting rejections maintained in the previous office action, Applicants did not address, however, upon reconsideration of the status of the applications, and the amendment, the provisional double patenting rejections based on co-pending applications 09/802,162, 10/050,088, and 10/825,776 are withdrawn herein and the rejection based on 10/234,069 is maintained herein as long as the scope of the co-pending claims remain within the scope of the instant claims.

Conclusion

No claims are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Suryaprabha Chunduru
Primary Examiner,
Art Unit 1637


SURYAPRABHA CHUNDURU 1/22/08
PRIMARY EXAMINER